

### **REMARKS**

Claims 1-5, 7-15 and 17-20 were pending in the application. Claim 1 is an independent claim, and claims 2-5 and 7-10 depend there from. Claim 11 is an independent claim, and claims 12-15 and 17-19 depend there from. Claim 20 is an independent claim. Claims 1, 4, 11, 14 and 20 are currently amended. Applicants respectfully request that the application be reconsidered in view of the amendments set forth above and the following remarks.

### **Interview Summary**

This summary is being submitted to place into the record of the above-identified application the substance of a telephone interview of August 14, 2007 between Examiner Christine D. Hopkins and her supervisor, and Applicant's representatives, Philip H. Sheridan. The following issues were discussed during the interview:

- Gatts discloses 2 operating modes (i.e., daytime and nighttime). Gatts' daytime operating mode has an increasing transition state (e.g., DAYS\_TON) and a constant state (e.g., DAYS\_ON). Gatts' nighttime operating mode has a decreasing transition state (e.g., DAYS\_TOFF) and a constant state (e.g., DAYS\_OFF). Gatts' states are not operating modes. Rather, Gatts merely discloses daytime and nighttime operating modes. Thus, Gatts fails to disclose "wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode." The Examiner disagreed. No agreement was reached.
- Gatts discloses daylight, lack of daylight and switch triggering events. One triggering event (e.g., daylight) triggers both the increasing transition period and the constant period when the daytime operating mode is triggered and both the decreasing transition period and the constant period when the nighttime operating mode is triggered (e.g., lack of daylight). Thus, because two periods are triggered by Gatts' one trigger, even if Gatts'

increasing and decreasing transitional states of its daytime and nighttime operating modes could be considered playback operating modes (which they cannot), Gatts still fails to disclose “determining...**a playback operating mode** from a plurality of operating modes **based on said received triggering event.**” The Examiner acknowledged that Gatts failed to disclose a separate trigger signal caused by an external triggering event for changing from the increasing transitional state to the constant state in the daytime operating mode and for changing from the decreasing transitional state to the constant state in the nighttime operating mode. The Examiner suggested amending the Applicant’s claims to clarify the claimed subject matter.

#### **Rejections Under 35 U.S.C. §103(a) – Gatts and Sheridan**

In point 3 on page 2 of the non-final Office Action, independent claims 1 and 11, and dependent claims 2-5, 7-8, 12-15 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatts et al., U.S. Patent 6,004,259 (hereinafter “Gatts”) in view of Sheridan, U.S. Patent No. 6,256,965. The Applicants respectfully traverse the rejections for at least the reasons set forth below.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal

Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

The proposed combination of Gatts and Sheridan are different from Applicant’s amended independent claim 1 since they do not teach or suggest by themselves or in combination, inter alia, the claimed method steps of “receiving by an audio enabled toy comprising a handheld stuffed animal, a first signal caused by a first at least one external triggering event,” “determining from within said audio enabled toy, a first playback operating mode from a plurality of playback operating modes based on said received first signal caused by said first at least one external triggering event, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,” “receiving by said audio enabled toy, a second signal caused by a second at least one external triggering event,” “determining from within said audio enabled toy, a second playback operating mode from said plurality of playback operating modes based on said received second signal caused by said second at least one external triggering event” and “changing said first playback operating mode to said second playback operating mode.”

Rather, Gatts discloses “automatically var[ying] the environmental stimuli of the cradle in a day-night cycle to simulate the mother’s activities while awake or sleeping.... The solar sensor 4 detects reduced ambient light and switches to the “nighttime” program of motion and sound. Of course, such day or night operating programs may also be implemented under control of a timer or manual switch.” (Gatts, Column 7, Lines 3-13 (emphasis added)). Gatts

further discloses cycling from state DAYS-OFF (i.e., constant nighttime heartbeat rate) to state DAYS-TON (i.e., increasing heartbeat rate) to state DAYS-ON (i.e., constant daytime heartbeat rate) to state DAYS-TOFF (i.e., decreasing heartbeat rate) back to DAYS-OFF (i.e., constant nighttime heartbeat rate), etc. (Gatts, Figures 10I (24) and 10H (20-23), Column 9, Line 56 – Column 10, Line 11). The Applicant notes that nowhere in Gatts is there any disclosure of deviating from the above-mentioned cycle. Sheridan merely discloses a “plush toy bed” having “a child safe pocket into which a sound reproduction device may be stored.” (Sheridan, Title and Claim 4).

The proposed combination of Gatts and Sheridan at least fail to disclose, for example, “receiving in said audio enabled toy, **a second signal caused by a second at least one external triggering event**,” “determining from within said audio enabled toy, a second playback operating mode from said plurality of playback operating modes **based on said received second signal caused by said second at least one external triggering event**” and “**changing said first playback operating mode to said second playback operating mode**,” as set forth in Applicant’s amended, independent claim 1. As discussed with the Examiner and her supervisor during the Examiner Interview, Gatts fails to disclose changing from state DAYS-TON to state DAYS-ON, for example, based on a received second at least one external triggering event. Rather, Gatts’ solar sensor detects a single light change which causes the change to the daytime operating mode, which includes the state DAYS-TON and state DAYS-ON. Further, an internal condition (e.g., change states once the heartbeat rate is ramped to a certain threshold) is not an external triggering event (e.g., detected motion, detected sound, detected switch change, etc.). Thus, the combination of Gatts and Sheridan cannot disclose “receiving in said audio enable toy, **a second signal caused by a second at least one external triggering event**,” “determining from within said audio enabled toy, a second playback operating mode from said plurality of playback operating modes **based on said received second signal caused by said second at least one external triggering event**” and “**changing said first playback operating mode to said second playback operating mode**,” as set forth in Applicant’s amended, independent claim 1.

Additionally, the proposed combination of Gatts and Sheridan at least fail to disclose, for example, “**determining** from within said audio enabled toy, **a second playback operating mode from said plurality of playback operating modes** based on said received second signal caused by said second at least one external triggering event,” as set forth in Applicant’s amended, independent claim 1. Even if the various states (e.g., DAYS-OFF, DAYS-TON, DAYS-ON and DAYS-TOFF) could be considered playback operating modes (which they cannot), Gatts merely discloses cycling through the states in a predetermined order. For example and as discussed above, Gatts merely discloses cycling from state DAYS-OFF (i.e., constant nighttime heartbeat rate) to state DAYS-TON (i.e., increasing heartbeat rate) to state DAYS-ON (i.e., constant daytime heartbeat rate) to state DAYS-TOFF (i.e., decreasing heartbeat rate) back to DAYS-OFF (i.e., constant nighttime heartbeat rate), etc. (Gatts, Figures 10I (24) and 10H (20-23), Column 9, Line 56 – Column 10, Line 11). Nowhere in Gatts is there any disclosure of deviating from the above-mentioned cycle. Thus, upon receiving a light or switch change in Gatts, the current state will always progress to the next state in order. For example, if Gatts is operating in DAYS-ON (i.e., daytime constant heartbeat state), a detected lack of light or switch change will cause Gatts to change to DAYS-TOFF state. Gatts does not disclose changing from DAYS-ON to DAYS-TON or DAYS-OFF upon receiving a detected lack of light or switch change. Thus, the combination of Gatts and Sheridan cannot disclose “**determining** from within said audio enabled toy, **a second playback operating mode from said plurality of playback operating modes** based on said received second signal caused by said second at least one external triggering event,” because when Gatts receives a light or switch change, Gatts merely teaches progressing to the next state in the cycle.

Also, the Applicant maintains that the plush toy bed disclosed in Sheridan is clearly not “a handheld stuffed animal,” as set forth in Applicant’s amended, independent claim 1. Thus, the combination of Gatts and Sheridan fails to disclose “receiving **by an audio enabled toy comprising a handheld stuffed animal**,” as set forth in Applicant’s amended, independent claim 1.

Further, the Applicant maintains that Gatts' states are not operating modes. Rather, Gatts merely discloses daytime and nighttime operating modes. Sheridan fails to remedy the deficiencies of Gatts. Thus, the combination of Gatts and Sheridan fails to disclose "wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode," as set forth in Applicant's amended, independent claim 1.

Additionally, the Applicant maintains that Gatts discloses daylight, lack of daylight and switch triggering events. One triggering event (e.g., daylight) triggers both the increasing transition period and the constant period when the daytime operating mode is triggered and both the decreasing transition period and the constant period when the nighttime operating mode is triggered (e.g., lack of daylight). Thus, because two periods are triggered by Gatts' one trigger, even if Gatts' increasing and decreasing transitional states of its daytime and nighttime operating modes could be considered playback operating modes (which they cannot), Gatts still fails to disclose **"determining...a first playback operating mode from a plurality of operating modes based on said received first signal caused by said first at least one external triggering event."**

With regard to Applicant's independent, amended claim 11, the proposed combination of Gatts and Sheridan are different from Applicant's amended independent claim 11 since they do not teach or suggest by themselves or in combination, *inter alia*, "a processing circuit of an audio enabled toy comprising a handheld stuffed animal, that receives a first signal caused by a first at least one external triggering event," "said processing circuit determines a first playback operating mode from a plurality of playback operating modes based on said received first signal caused by said first at least one external triggering event and selects from within said audio enabled toy, at least one sound that mimics a mother's sound from a plurality of mother's sounds based on said determined playback operating mode, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode" and "wherein said first playback operating mode is changed to a second

playback operating mode determined by said processing circuit from said plurality of operating modes based on a received second signal caused by a second at least one external triggering event.”

The proposed combination of Gatts and Sheridan at least fail to disclose, for example, “wherein said first playback operating mode is changed to a second playback operating mode determined by said processing circuit from said plurality of operating modes **based on a received second signal caused by a second at least one external triggering event**,” as set forth in Applicant’s amended, independent claim 11. As discussed with the Examiner and her supervisor during the Examiner Interview, Gatts fails to disclose changing from state DAYS-TON to state DAYS-ON, for example, based on a received second at least one external triggering event. Rather, Gatts’ solar sensor detects a single light change which causes the change to the daytime operating mode, which includes the state DAYS-TON and state DAYS-ON. Further, an internal condition (e.g., change states once the heartbeat rate is ramped to a certain threshold) is not an external triggering event (e.g., detected motion, detected sound, detected switch change, etc.). Thus, the combination of Gatts and Sheridan cannot disclose “wherein said first playback operating mode is changed to a second playback operating mode determined by said processing circuit from said plurality of operating modes **based on a received second signal caused by a second at least one external triggering event**,” as set forth in Applicant’s amended, independent claim 11.

Additionally, the proposed combination of Gatts and Sheridan at least fail to disclose, for example, “wherein said first playback operating mode is changed to a second playback operating mode **determined by said processing circuit from said plurality of operating modes** based on a received second signal caused by a second at least one external triggering event,” as set forth in Applicant’s amended, independent claim 11. Even if the various states (e.g., DAYS-OFF, DAYS-TON, DAYS-ON and DAYS-TOFF) could be considered playback operating modes (which they cannot), Gatts merely discloses cycling through the states in a predetermined order. For example and as discussed above, Gatts merely discloses cycling from state DAYS-OFF (i.e., constant nighttime heartbeat rate) to state DAYS-TON (i.e., increasing heartbeat rate) to state

DAYS-ON (i.e., constant daytime heartbeat rate) to state DAYS-TOFF (i.e., decreasing heartbeat rate) back to DAYS-OFF (i.e., constant nighttime heartbeat rate), etc. (Gatts, Figures 10I (24) and 10H (20-23), Column 9, Line 56 – Column 10, Line 11). Nowhere in Gatts is there any disclosure of deviating from the above-mentioned cycle. Thus, upon receiving a light or switch change in Gatts, the current state will always progress to the next state in order. For example, if Gatts is operating in DAYS-ON (i.e., daytime constant heartbeat state), a detected lack of light or switch change will cause Gatts to change to DAYS-TOFF state. Gatts does not disclose changing from DAYS-ON to DAYS-TON or DAYS-OFF upon receiving a detected lack of light or switch change. Thus, the combination of Gatts and Sheridan cannot disclose “wherein said first playback operating mode is changed to a second playback operating mode **determined by said processing circuit from said plurality of operating modes** based on a received second signal caused by a second at least one external triggering event,” because when Gatts receives a light or switch change, Gatts merely teaches progressing to the next state in the cycle.

Also, the Applicant maintains that the plush toy bed disclosed in Sheridan is clearly not “a handheld stuffed animal,” as set forth in Applicant’s amended, independent claim 11. Thus, the combination of Gatts and Sheridan fails to disclose “a processing circuit **of an audio enabled toy comprising a handheld stuffed animal**,” as set forth in Applicant’s amended claim 11.

Further, the Applicant maintains that Gatts’ states are not operating modes. Rather, Gatts merely discloses daytime and nighttime operating modes. Thus, the combination of Gatts and Sheridan fails to disclose “wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,” as set forth in Applicant’s amended, independent claim 11

Additionally, the Applicant maintains that Gatts discloses daylight, lack of daylight and switch triggering events. One triggering event (e.g., daylight) triggers both the increasing transition period and the constant period when the daytime operating mode is triggered and both the decreasing transition period and the constant period when the nighttime operating mode is triggered (e.g., lack of daylight). Thus, because two periods are triggered by Gatts’ one trigger,



even if Gatts' increasing and decreasing transitional states of its daytime and nighttime operating modes could be considered playback operating modes (which they cannot), Gatts still fails to disclose "said processing circuit **determines a first playback operating mode** from a plurality of playback operating modes **based on said received first signal caused by said first at least one triggering event.**"

The Applicant respectfully submits that, based upon the above, the proposed combination of Gatts and Sheridan fails to teach or suggest by themselves or in combination all of the limitations of Applicant's independent claims 1 and 11, and that rejections of claim 1 and 11 under 35 U.S.C. §103(a) cannot be maintained. Therefore, Applicant respectfully requests that the rejections of claim 1 and 11 under 35 U.S.C. §103(a), be withdrawn.

Because dependent claims 2-5, 7-8, 12-15 and 17-18 depend, directly or indirectly, from independent claim 1 or 11, and because claims 1 and 11 are allowable over the proposed combination of references, the Applicant asserts that rejections of dependent claims 2-5, 7-8, 12-15 and 17-18 are now moot. The Applicant asserts that claims 2-5, 7-8, 12-15 and 17-18 are also allowable over the proposed combination of references and requests that the rejections of claims 2-5, 7-8, 12-15 and 17-18 be withdrawn.

#### **Rejections Under 35 U.S.C. §103(a) – Gatts, Sheridan and Kulick**

In point 4 on page 5 of the non-final Office Action, independent claim 20, and dependent claims 9, 10 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatts in view of Sheridan and further in view of Kulick, U.S. Patent No. 6,692,330. The Applicants respectfully traverse the rejections for at least the reasons set forth below.

The proposed combination of Gatts, Sheridan and Kulick are different from Applicant's amended, independent claim 20 since they do not teach or suggest by themselves or in combination, inter alia, "a switch having a plurality of switch settings and coupled to a processing circuit, wherein each of a plurality of playback operating modes is associated with a different one of said plurality of switch settings," and "a mode control unit coupled to said processing circuit for determining a playback operating mode from said plurality of playback operating modes based on a selected switch setting of said plurality of switch settings, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode."

The proposed combination of Gatts, Sheridan and Kulick at least fail to disclose, for example, "a switch having a plurality of switch settings and coupled to a processing circuit, wherein **each of a plurality of playback operating modes is associated with a different one of said plurality of switch settings,**" as set forth in Applicant's amended, independent claim 20. Even if Gatts DAYS-TON, DAYS-ON, DAYS-TOFF and DAYS-OFF states could be considered playback operating modes (which they cannot), Gatts fails to disclose at least the DAYS-ON and DAYS-OFF states being associated with a switch setting different from states DAYS-TON and DAYS-TOFF. Sheridan and Kulick fail to remedy the deficiencies of Gatts. Thus, the combination of Gatts, Sheridan and Kulick fail to disclose "a switch having a plurality of switch settings and coupled to a processing circuit, wherein **each of a plurality of playback operating modes is associated with a different one of said plurality of switch settings,**" as set forth in Applicant's amended, independent claim 20.

Further, the Applicant maintains that Gatts' states are not operating modes. Rather, Gatts merely discloses daytime and nighttime operating modes. Sheridan and Kulick fail to remedy the deficiencies of Gatts. Thus, the combination of Gatts, Sheridan and Kulick fails to disclose "wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode," as set forth in Applicant's amended, independent claim 20.

Additionally, the Applicant maintains that Gatts switch triggers both the increasing transition period and the constant period when switched to the daytime operating mode and both the decreasing transition period and the constant period when switched to the nighttime operating mode. Thus, because two periods are triggered by Gatts' switch, even if Gatts' increasing and decreasing transitional states of its daytime and nighttime operating modes could be considered playback operating modes (which they cannot), Gatts still fails to disclose "a mode control unit coupled to said processing circuit for **determining a playback operating mode** from said plurality of playback operating modes **based on a selected switch setting of said plurality of switch settings.**"

The Applicant respectfully submits that, based upon the above, the proposed combination of Gatts, Sheridan and Kulick fails to teach or suggest by themselves or in combination all of the limitations of Applicant's independent claim 20, and that rejection of claim 20 under 35 U.S.C. §103(a) cannot be maintained. Therefore, Applicant respectfully requests that the rejection of claim 20 under 35 U.S.C. §103(a), be withdrawn.

As discussed previously with regard to at least independent claims 1 and 11, Gatts, Sheridan and the combination of Gatts and Sheridan does not teach all of the claim limitations. Accordingly, Gatts, Sheridan and the combination of Gatts and Sheridan does not teach all of the limitations of any of the associated dependent claims, including claims 9, 10 and 19. Additionally, Kulick fails to make up for the aforementioned deficiencies of Gatts, Sheridan and the combination of Gatts and Sheridan.

Accordingly, based at least on the foregoing, including arguments presented previously with regard to independent claims 1 and 11, the Applicant respectfully submits that dependent claims 9, 10 and 19 are allowable over Gatts, Sheridan, Kulick and any combination of Gatts,

Sheridan and Kulick. Therefore, the Applicant respectfully requests that the rejections of claims 9, 10 and 19 be withdrawn.

### **Final Matters**

The Office Action makes various statements regarding former claims 1-5, 7-15 and 17-20, 35 U.S.C. § 103(a), the Gatts reference, the Sheridan reference, the Kulick reference, one skilled in the art, etc. that are now moot in view of the previously presented amendments and/or arguments. Thus, the Applicants will not address all of such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 1-5, 7-15 and 17-20 should the need arise in the future.

**CONCLUSION**

Applicant respectfully submits that claims 1-5, 7-15 and 17-20 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: November 4, 2008

Respectfully submitted,

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